

Applicant: Kelly S. Stack
Serial No.: 10/602,446
Filing Date: June 24, 2003
Docket No.: STK-001

REMARKS

Reconsideration and allowance is respectfully requested.

Before entry of this amendment, claims 1-20 were pending. In the Office Action, claims 1-20 were rejected. In the present amendment, claims 1, 10-11 and 17-18 are amended, claim 6 is canceled, and claim 21 is added. After entry of the amendment, claims 1-5 and 7-21 are pending.

I. Claim 10

Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 10 has been amended to overcome this rejection.

II. Claims 1-4, 6-20

Claims 1-4, 6-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McKay (USP 5,305,470) in view of Wilson et al. (published as 2004/0098073 and issued as USP 7,060,086) (Office Action, p. 4, lines 3-4). To establish a *prima facie* case of obviousness, the Examiner must demonstrate three criteria. The MPEP § 2142 states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claimed limitations." MPEP § 2142 (emphasis added).

A. Independent claim 1

The combination of McKay and Wilson does not form the basis for a valid rejection of claim 1 under § 103(a) because the references when combined do not teach all of the claim elements, and there is no motivation to modify the

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teachings of McKay with the teachings of Wilson to arrive at the limitations of claim 1.

Claim 1 as amended recites, "a bracelet . . . adapted to be attached around an infant's wrist, . . . wherein the bracelet is made of plural layers of fabric on the wrist-facing side and a single layer of the fabric on the outer side, . . . and wherein the fabric is non-absorbent; and a plurality of capsules . . . wherein the bracelet is adapted to allow the infant to suck on one of the plurality of capsules through the fabric" (emphasis added). Neither McKay nor Wilson teaches either (i) a bracelet adapted to be attached around an infant's wrist, (ii) a bracelet made of non-absorbent fabric, or (iii) a bracelet that is adapted to allow an infant to suck on a capsule through the fabric.

- (i) Neither McKay nor Wilson teaches a bracelet adapted to be attached around an infant's wrist.

The Examiner states that McKay discloses "a bracelet (fig. 1) . . . adapted to be attached around an infant's wrist" (Office Action, p. 4, lines 5-6). Applicant respectfully disagrees. The Examiner has not stated where McKay teaches that the sports band 10 of figure 1 is adapted to be attached around an infant's wrist. In fact, McKay is directed to a sports band and does not mention infants. Wilson also does not mention infants or babies.

To the extent the Examiner is arguing that the sports band 10 of McKay is inherently adapted to be attached around an infant's wrist, the Examiner is asked to present extrinsic evidence of this fact. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)" *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367 (Fed. Cir. 2004) (emphasis added). Being adapted to be attached around an infant's wrist is not an inherent characteristic of a sports band. The Examiner

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has not established a *prima facie* case of obviousness because the cited references do not teach this characteristic and the Examiner has provided no extrinsic evidence teaching that the characteristic is necessarily present in the sports band of McKay.

The Examiner argues, "McKay does not expressly disclose attaching the bracelet to the wrist of an infant. 15. However, Wilson et al. discloses that the wearer of a cooling device may be a child [0046], which defines an age range that includes infants and it would be obvious to one of ordinary skill to employ the cooling device of McKay on an infant since thermal treatment is useful for people of all ages." (Office Action, p. 5, lines 4-11) Wilson does not teach that the age range of a "child" who wears thermal treatment pack 100 includes an infant. To the contrary, Wilson is directed to the treatment of injured limbs. (See, e.g., Wilson, col. 1, lines, 14, 28, 30-31, 37, 42, 47, 49, 54, 56, 59-60, 62-63, 66; col. 2, lines 4, 10, 18, 23, 25, 27, 31, 33, 35, 38-39, 41-42, 44-45, 47, 50, 54, 67) Wilson does not suggest that thermal treatment pack 100 should be used on injured limbs of infants. Indeed, one of ordinary skill in the art of the treatment of injured limbs is not necessarily one of ordinary skill in the art of the treatment of infants. Similarly, it would not have been obvious to one of ordinary skill in the art of the treatment of injured limbs to attach the sports band 10 of McKay to the wrist of an infant. McKay is directed to competitive sports. (See, e.g., McKay, col. 2, lines 51-56). One of ordinary skill in the art of the treatment of injured limbs as a result of competitive sports is not necessarily one of ordinary skill in the art of the treatment of infants.

(ii) Neither McKay nor Wilson teaches a bracelet made of non-absorbent fabric.

Neither McKay nor Wilson teaches using a non-absorbent fabric. Indeed, McKay teaches away from a sports band made of non-absorbent fabric. McKay states:

"The present invention relates generally to sports apparel and more particularly to a sports band for absorbing perspiration and for

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cooling the wearer. The sports band is either comprised of a hollow band of elastic absorbent material." (McKay, col. 1, lines 12-16) (emphasis added).

"Thus, it would be desirable to provide a sports band which would both absorb the user's perspiration and provide cooling to the user." (McKay, col. 1, lines 65-67) (emphasis added).

"[T]he present invention comprises a sports band for absorbing perspiration and for cooling the wearer. In a first embodiment, the sports band is comprised of a band of elastic absorbent material." (McKay, col. 2, lines 5-9) (emphasis added).

"Thus, a user may wear the sports band of the present invention to improve performance by both absorbing perspiration and cooling the user." (McKay, col. 2, lines 51-53) (emphasis added).

"The sports band of the present invention is illustrated in FIGS. 1-8 which depict two presently preferred embodiments of the invention. Referring now to FIGS. 1-3, a first embodiment of the sports band 10 is comprised generally of a band 22 of an elastic absorbent material," (McKay, col. 3, lines 40-45) (emphasis added).

(iii) Neither McKay nor Wilson teaches a bracelet that is adapted to allow an infant to suck on a capsule through the fabric.

Neither McKay nor Wilson teaches sucking on a capsule through the fabric of a bracelet. McKay does not teach that sports band 10 contains capsules that could be sucked on. Moreover, McKay does not teach that its sports band is adapted to be sucked on.

The Examiner states, "the thermal pack of Wilson does contain capsules that are adapted to allow an infant to suck on the capsule" (Office Action, p. 2, lines 15-16). Applicant respectfully disagrees. The Examiner has not stated where Wilson teaches that capsules in thermal treatment pack 100 are adapted to allow an infant to suck on the capsules. Wilson does not teach that thermal treatment pack 100 is adapted to be sucked on. In fact, Wilson contains no teachings relating to either sucking or infants.

To the extent the Examiner is arguing that "any small substantially free-flowing solid structure" (Wilson, col. 5, lines 17-18) in the thermal treatment pack 100 of Wilson is inherently adapted to allow an infant to suck on the structure

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through a fabric layer of the thermal treatment pack, the Examiner is asked to present extrinsic evidence of this fact. Applicant maintains that the quality of enabling an infant to suck on an inner capsule is not necessarily present in the thermal treatment pack 100 of Wilson.

(iv) There is no motivation to modify the teachings of McKay with the teachings of Wilson.

There is no motivation to modify the teachings of McKay with the teachings of Wilson to arrive at the limitations of claim 1. Even if Wilson were to teach that thermal treatment pack 100 is adapted to allow an infant to suck on a capsule through a fabric layer (which Wilson does not), there would be no motivation to combine the teachings of Wilson with the teachings of McKay because McKay teaches away from using a non-absorbent fabric. Thus, McKay teaches away from modifying sports band 10 with any teachings of Wilson to arrive at the limitations of claim 1. Even if Wilson were to teach a thermal treatment pack adapted to being sucked by an infant (which it does not), that teaching combined with the teaching of McKay would result in a thermal treatment pack that becomes wet with the infant's saliva or with condensation from the cold capsule. Such a combination would not result in all the limitations of claim 1 and would not produce a reasonable expectation of success.

McKay and Wilson do not form the basis for a valid rejection of claim 1 under § 103(a) because (i) the combination of McKay and Wilson does not teach at least three of the limitations of claim 1, and (ii) there is no motivation to combine Wilson with the teachings of McKay to arrive at all of the limitations of claim 1. Reconsideration of the § 103(a) rejection and allowance of claim 1 are requested

B. Dependent claims 2-4 and 7-10

Claims 2-4 and 7-10 depend directly or indirectly from claim 1 and are allowable for at least the same reasons for which claim 1 is allowable.

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Reconsideration of the § 102(e) rejection and allowance of claims 2-4 and 7-10 are requested.

C. Independent claim 11

Claim 11 recites, "enclosing a substance in a capsule in a bracelet, wherein the bracelet is made of a non-absorbent fabric; . . . wherein the capsule is adapted to allow the infant to suck on the capsule through the non-absorbent fabric" (emphasis added). The combination of McKay and Wilson does not form the basis for a valid rejection of claim 11 under § 103(a) because the references when combined do not teach (i) a bracelet made of non-absorbent fabric, or (ii) a capsule that is in a bracelet and that is adapted to allow an infant to suck on the capsule through the non-absorbent fabric. In addition, there is no motivation to modify the teachings of either McKay or Wilson to arrive at all of the limitations of claim 11.

- (i) Neither McKay nor Wilson teaches a bracelet made of non-absorbent fabric.

Neither McKay nor Wilson teaches using a non-absorbent fabric. As explained above with regard to claim 1, McKay teaches away from a sports band made of non-absorbent fabric.

- (ii) Neither McKay nor Wilson teaches a capsule that is adapted to allow an infant to suck on the capsule through the non-absorbent fabric.

The Examiner states, "The capsule is adapted to allow the infant to suck on the capsule through the fabric, as the fabric and cold pack materials are flexible. McKay does not expressly disclose attaching the bracelet to the wrist of an infant. 15. However, Wilson et al. discloses that the wearer of a cooling device may be a child [0046], which defines an age range that includes infants and it would be obvious to one of ordinary skill to employ the cooling device of McKay on an infant since thermal treatment is useful for people of all ages." (Office Action, p. 5, lines 4-11)

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McKay is directed to a sports band for competitive sports. (See, e.g., McKay, col. 2, lines 51-56). The Examiner admits that McKay does not teach a capsule in a thermal treatment pack that is adapted to allow an infant to suck on the capsule. Wilson involves thermal treatment packs used to treat injured limbs. Wilson does not teach a capsule in a thermal treatment pack that is adapted to allow an infant to suck on the capsule. Wilson does not mention infants. As explained above with regard to claim 1, Wilson does not teach that the age range of a "child" who wears thermal treatment pack 100 includes an infant, and Wilson does not suggest that thermal treatment pack 100 should be used on injured limbs of infants.

(iii) There is no motivation to modify the teachings of McKay and Wilson to arrive at the limitations of claim 11.

Applicant disagrees with the Examiner's statement that "it would be obvious to one of ordinary skill to employ the cooling device of McKay on an infant since thermal treatment is useful for people of all ages." (Office Action, p. 5, lines 9-11) One of skill in the art of Wilson or McKay would not have been motivated by issues relating to infants. Indeed, one of ordinary skill in the art of the treatment of injured limbs is not necessarily one of ordinary skill in the art of the treatment of infants. Similarly, it would not have been obvious to one of ordinary skill in the art of the treatment of injured limbs to attach the sports band 10 of McKay to the wrist of an infant. McKay is directed to competitive sports. (See, e.g., McKay, col. 2, lines 51-56). One of ordinary skill in the art of the treatment of injured limbs as a result of competitive sports is not necessarily one of ordinary skill in the art of the treatment of infants. Neither McKay nor Wilson teaches allowing an infant to suck on a capsule, and there would be no motivation to those of skill in the art of McKay and Wilson to modify the teachings of McKay and Wilson to arrive at a capsule adapted to allow an infant to suck on the capsule.

Because Wilson does not disclose all of the elements of claim 11, reconsideration of the § 102(e) rejection and allowance of claim 11 are

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requested.

McKay and Wilson do not form the basis for a valid rejection of claim 11 under § 103(a) because (i) the combination of McKay and Wilson does not teach all of the limitations of claim 11, and (ii) there is no motivation to modify Wilson and McKay to arrive at all of the limitations of claim 1. Reconsideration of the § 103(a) rejection and allowance of claim 11 are requested.

D. Dependent claims 12-18

Claims 12-18 depend directly or indirectly from claim 11 and are allowable for at least the same reasons for which claim 11 is allowable. Reconsideration of the § 102(e) rejection and allowance of claims 12-18 are requested.

E. Independent claim 19

Claim 19 recites a teether. In addition, claim 19 recites, "means for attaching the capsule to a wrist of an infant, . . . and for allowing the infant to suck on the capsule through the means". The combination of McKay and Wilson does not form the basis for a valid rejection of claim 19 under § 103(a) because the references when combined do not teach (i) a teether, or (ii) a means for attaching a capsule to an infant's wrist and for allowing the infant to suck on the capsule. In addition, there is no motivation to modify the teachings of either McKay or Wilson to arrive at these limitations.

Neither McKay nor Wilson teaches a teether. The Examiner has not established a *prima facie* case of obviousness because the Examiner has not stated that either McKay or Wilson teaches a teether. Neither McKay nor Wilson even mentions teeth.

In addition, neither McKay nor Wilson teaches attaching a capsule to an infant's wrist and allowing the infant to suck on the capsule. Neither McKay nor Wilson mentions infants or sucking. As explained above, McKay is directed to a sports band for competitive sports, and Wilson involves thermal treatment packs used to treat injured limbs. Neither McKay nor Wilson teaches a capsule in a

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sports band or thermal treatment pack that is adapted to allow an infant to suck on the capsule. As explained above with regard to claim 1, Wilson does not teach that the age range of a "child" who wears thermal treatment pack 100 includes an infant, and Wilson does not suggest that thermal treatment pack 100 should be used on injured limbs of infants. In addition, Wilson does not teach or suggest that thermal treatment pack 100 should be applied to the teeth of infants.

Finally, one of ordinary skill in the art of the treatment of injured limbs as a result of competitive sports would not have been motivated to modify the teachings of McKay and Wilson to arrive at attaching a capsule to an infant's wrist and allowing the infant to suck on the capsule.

Because McKay and Wilson do not teach all of the limitations of claim 19, and because there is no motivation to modify Wilson and McKay to arrive at all of the limitations of claim 19, reconsideration of the § 103(a) rejection and allowance of claim 19 are requested.

F. Dependent claims 20-21

Claims 20-21 depend from claim 19 and are allowable for at least the same reasons for which claim 19 is allowable. Reconsideration of the § 103(a) rejection of claim 20 and allowance of claims 20-21 are requested.

III. Dependent claim 5

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over McKay in view of Wilson and further in view of Brink (USP 5,843,145) (Office Action, p. 7, lines 17-18).

Claim 5 includes the following limitations of base claim 1, "a bracelet . . . adapted to be attached around an infant's wrist, . . . wherein the bracelet is made of plural layers of fabric on the wrist-facing side and a single layer of the fabric on the outer side, . . . and wherein the fabric is non-absorbent; and a plurality of capsules . . . wherein the bracelet is adapted to allow the infant to suck on one of the plurality of capsules through the fabric" (emphasis added). None of McKay,

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Wilson or Brink teaches either (i) a bracelet adapted to be attached around an infant's wrist, (ii) a bracelet made of non-absorbent fabric, or (iii) a bracelet that is adapted to allow an infant to suck on a capsule through the fabric".

McKay and Wilson do not teach these limitations as explained above. Brink does not teach any of a bracelet, an infant or a wrist. Brink does not teach fabric. And finally, Brink does not teach allowing an infant to suck on a capsule.

Because McKay, Wilson and Brink do not teach all of the limitations of claim 5, reconsideration of the § 103(a) rejection and allowance of claim 5 are requested.

IV. New claim 21

Applicant is adding new claim 21, which is supported by the specification and allowable over the cited references. No new matter is added

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the entire application (claims 1-5 and 7-21 are pending) is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 550-5067.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Respectfully submitted,

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